



PATENT
Attorney Docket No.: DIVER1230-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Mathur *et al.*

Application No.: 09/202,681

Filed: December 23, 1999

For: THERMOSTABLE PHOSPHATASES

) Group Art Unit: 1652

) Examiner: R. Hutson

) CERTIFICATION UNDER 37 CFR § 1.8

) I hereby certify that the documents referred to as enclosed
) herein are being deposited with the United States Postal Service
) as first class mail on this date January 30, 2001, in an envelope
) addressed to Commissioner for Patents, Washington, D.C.
) 20231

) Lucille M. Begalle
(Name of person mailing paper)

Lucille M. Begalle January 30, 2001
Signature Date

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO SPECIES ELECTION

Sir:

In response to the Restriction Requirement mailed November 30, 2000, Applicants elect the sequence of SEQ ID NO: 19 with traverse and respectfully request rejoinder of at least SEQ ID Nos: 19-27 and 43, which are all thermostable phosphatases.

The Examiner is respectfully directed to MPEP §803.04 "Restriction - Nucleotide Sequences" and 37 CFR 1.141(a), which set forth the requirements and the examination of more than one nucleotide sequence directed to possible distinct polypeptide sequences. MPEP §803.04 states in part,

"[T]o further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided sua sponte to partially waive the requirements of 37 CFR 1.141 et seq. and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See Examination of Patent Applications Containing

In re Application of:
R. Hutson et al.
Application No.: 09/202,681
Filed: December 23, 1999
Page 2

PATENT
Attorney Docket No.: DIVER1230-1
(09010/045001)

Nucleotide Sequences, 1192 O.G. 68 (November 19, 1996). It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten **independent** and **distinct** nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together. In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten. In other cases, applicants may petition pursuant to 37 CFR 1.181 for examination of additional nucleotide sequences by providing evidence that the different nucleotide sequences do not cover independent and distinct inventions.

(Emphasis Added).

As described in the present specification SEQ ID NOs: 19-27 and 43 share common functional characteristics-they are all thermostable phosphatases. Applicants respectfully point out that searching all of these sequences would not unduly burden the Examiner because the sequences could be searched and then similar art could be searched for functional similarity. In addition, according to MPEP §803.04, "up to ten independent and distinct nucleotide sequences will be examined." Applicants submit that sequences corresponding to SEQ ID Nos: 19-27 and 43 are ten sequences which have a high degree of at least functional identity, and satisfy the requirements of MPEP §803.04. Thus, examination of these sequences together is requested in accordance with MPEP §803.04.

In order to be fully responsive to the Restriction Requirement, Applicants elect, with traverse, SEQ ID NO:19, drawn to the species of thermostable phosphatase.

In re Application of:
R. Hutson et al.
Application No.: 09/202,681
Filed: December 23, 1999
Page 3

PATENT
Attorney Docket No.: DIVER1230-1
(09010/045001)

If it appears that a telephone conference would helpfully advance prosecution, please
telephone the undersigned at (858) 677-1456.

Respectfully submitted,

Date: 1/30/01



Lisa A. Haile, Ph.D.
Registration No. 38,347
Telephone: (858) 677-1456
Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1600
San Diego, CA 92121-2189